

REMARKS

Claims 1-29 are pending in the above-identified application. Claims 1-4, 8-10, 12, 15, 22-23, 26 and 28-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ginter* (U.S. Patent No. 5,892,900) in view of *Moreh* (U.S. Patent No. 6,158,007). Claims 5-7, 19-21 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Ginter* and *Moreh*, as applied to claims 1, 15 and 26 above, and further in view of *Lee et al.* (U.S. Patent No. 6,636,966). Claims 11 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Ginter* and *Moreh*, as applied to claims 1 and 15 above, in further view of "IBM Cryptolopes, SuperDistribution and Digital Rights Management" by *Kaplan*. Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Ginter* and *Moreh*, as applied to claim 1 above, in further view of *Traw et al.* (U.S. Patent No. 5,949,877). Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Ginter* and *Moreh*, as applied to claim 1 above, in further view of *Shockley et al.* (U.S. Patent No. 5,534,855). Applicant respectfully traverses these rejections.

In the office action, the Examiner admits that *Ginter* does not disclose that "authentication is performed in accordance with the identification certificate identified on the basis of the identification certificate identifier list when said secure container is moved, so that the content usable on said user device is distributed with content transaction managed." The Examiner then assert that this limitation is taught by *Moreh*. Applicant respectfully disagrees.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP Section. 2143.01 (emphasis added). Here,

there is no such teaching, suggestion or motivation to combine *Moreh* with *Ginter*. In fact, *Ginter* teaches away from doing so.

Ginter, as the Examiner points out, mentions that "an office 210 may...permit only specified employees and/or groups to access certain information." However, as the Examiner admits, *Ginter* then does not teach that authentication is performed in accordance with the identification certificate identified on the basis of the identification certificate identifier list. As *Ginter* fails to teach performing such authentication even after specifically envisioning setting up a group of permitted users, one skilled in the art reading *Ginter* would understand that not performing such authentication was a purposeful choice in *Ginter*. Accordingly, there would be no motivation to combine the teachings of *Moreh* with the system of *Ginter*, in order to create a feature that *Ginter* appears to have rejected. If the Examiner continues to present the present rejection, Application requests that the Examiner point to specific portions in *Ginter* that provide the requisite motivation.

Accordingly, Applicant submits that independent claim 1, as well as dependent claims 2-14 are allowable. For similar reasons, Applicant submits that claims 15-29 are also allowable.

In view of the foregoing, Applicants submit that the application is in condition for allowance. Notice to that effect is requested.

Respectfully submitted,

Dated: May 30, 2006

By: /David R. Metzger/

David R. Metzger

Registration No. 32,919

SONNENSCHNEIDER NATH & ROSENTHAL LLP

P.O. Box 061080

Wacker Drive Station, Sears Tower

Chicago, Illinois 60606-1080

(312) 876-8000